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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,662	09/29/2003	Jeffrey S. Swayze	END5131.0517373	2356

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09/07/2004

FROST BROWN TODD LLC
2200 PNC Center
201 E. Fifth Street
Cincinnati, OH 45202-4182

EXAMINER

NASH, BRIAN D

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,662

Applicant(s)

SWAYZE ET AL.

Examiner

Brian D Nash

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/29/03.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 7, 11, 14 and 19 are objected to because of the following informalities: In claim 7, line 1, "...includes least..." is awkward. It appears that "at" is missing. In claim 11, line 2, "...surface is comprises..." is awkward. In claim 14, "...between about..." is confusing. In claim 19, line 4, "...user to operably configured to..." is awkward. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 8-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 5 and 8, the entire claim is vague, indefinite, and confusingly worded because it is not clear what structural limitations applicant is claiming. Additionally in claims 5 and 16, the terminology appears to contradict itself, e.g. "frictionally biased to decouple". This is confusing because frictional bias implies physical contact between surfaces while decouple implies the disconnection of two surfaces.

In claim 10, the phrase "wherein a selected one of a group consisting of" is confusing because it is not clear what structural limitations applicant is claiming.

In claim 15, it is not clear how a surface comprises a wheel? Is the surface a wheel or does applicant intend a different structural limitation, e.g. the surface contains a wheel on or within itself?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 12-13, 15, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,465,895 to Knodel et al. Knodel et al show the same invention, a surgical apparatus having an end effector (see Fig. 1, not referenced), a shaft (152), a firing member (160,162), a handle (130), a firing control (140), a closure means (150) with an arcuate surface (150b, Fig. 3), a firing mechanism coupled with the firing member (see column 8, lines 29-46); wherein the end effector has an elongate channel (112), a pivotally coupled anvil (114), and a staple cartridge (120). Knodel et al further show a rack (164,182) movably coupled (via 170) with the firing member and the firing mechanism.

6. Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,762,256 to Mastri et al. Mastri et al show the same invention, a surgical apparatus having an end effector (see Fig. 1, not referenced), a shaft (14) connected thereto and a firing member (64) received by the shaft, a handle (12), a rack (42), a firing control (26), and a firing mechanism (40) including a pawl (44); wherein the end effector has a stapling device (30), an elongate channel (110), a pivotally coupled anvil (36), and a staple cartridge (34).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,465,895 to Knodel et al. As discussed above in this office action, Knodel et al show the same invention substantially as claimed, but do not mention an elastomeric material or a material having a coefficient of friction between 0.04 and 0.4 used for one of the biasing surfaces. It would have been an obvious matter of design choice to have incorporated either material choice for one of the biasing surfaces since elastomers and materials having varying coefficients of friction are both well known in the art and applicant has not disclosed that either material solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either design choice as evidenced by the apparatus of Knodel et al.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is (703) 305-4959. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 703 308-2187.

The fax number for this Group is: 703-872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.


SCOTT A. SMITH
PRIMARY EXAMINER